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Commissioner for Patents
PO Box 1450
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Art Unit 1617

Attn: Mail Stop Amendment

Re: U.S. Utility Patent Application
Application No. 10/801,951; Filed: March 17, 2004
For: **Facially Amphiphilic Polymers and Oligomers and Uses Thereof**
Inventors: DeGRADO *et al.*
Our Ref: 1694.0630003/JMC/AES

Sir:

Transmitted herewith for appropriate action is a **Reply to Restriction and Election of Species Requirement**.

The above-listed documents are filed electronically through EFS-Web.

In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

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AES/las
Enclosures
635790_1.DOC

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

DeGRADO *et al.*

Appl. No.: 10/801,951

Filed: March 17, 2004

For: **Facially Amphiphilic Polymers and
Oligomers and Uses Thereof**

Confirmation No.: 2895

Art Unit: 1617

Examiner: Chong, Yong Soo

Atty. Docket: 1694.0630003/JMC/AES

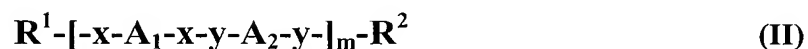
Reply to Restriction and Election of Species Requirement

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the Restriction and Election of Species Requirement dated December 28, 2006, requesting an election of one invention to prosecute in the captioned patent application, Applicants hereby provisionally elect to prosecute the invention of Group III, represented by claims 16-48 (in part) and 67-68, which are drawn to a method of treating a microbial infection in an animal by administering an oligomer of Formula II, wherein x and y are taken together to be an amide, and wherein either A1 or A2 is an arylene and the other is a heteroarylene, optionally substituted with polar and/or non-polar groups. This election was made without prejudice to or disclaimer of the other claims or inventions disclosed.

Applicants also provisionally elected the single oligomer of Formula II:



wherein: x is NR⁸; R⁸ is hydrogen; y is C=O; A₁ is *m*-phenylene substituted with one polar group and one non-polar group, wherein the polar group is -(NR^{5'})_{q1PL}-U^{PL}-(CH₂)_{pPL}-(NR^{5'})_{q2PL}-V wherein U^{PL} is S, pPL is 2, q1PL and q2PL are 0, and V is amino, and the non-polar group is -(NR^{3'})_{q1NPL}-U^{NPL}-(CH₂)_{pNPL}-(NR^{3'})_{q2NPL}-R^{4'} wherein U^{NPL} is absent, pNPL is 0, q1NPL and q2NPL are 0, and R^{4'} is *t*-butyl; A₂ is unsubstituted pyrimidinylene; R¹ is the polar group -(NR^{5'})_{q1PL}-U^{PL}-(CH₂)_{pPL}-(NR^{5'})_{q2PL}-V wherein U^{PL} is -C(=O)-, pPL is 4, q1PL and q2PL are 0, and V is guanidino; R² is -x-A₁-x-R¹ wherein x, A₁, and R¹ are as defined above; and m is 1. The oligomer elected by Applicants is disclosed in the captioned specification at page 100, as the third compound from the top of the page. Claims 16, 17, 22, 23, 24, 26, 27, 28, 31, 32, 35, 36, 37, 39, 41, 42, 43, 44, 46, 47, 67 and 68 read on this species.

This election is made **with** traverse.

Claims 16-48 and 66-68 recite amphiphilic oligomers which all share the common structural feature of amphiphilicity and the common utility of effectiveness in the claimed method. Thus, restriction should not be required and all groups should be examined together.

At the very least, however, Applicants submit that the claims of Group III should be examined with those of Groups I and II, because all three groups require that x and y form an amide linkage between the A₁ and A₂ backbone rings, and all three groups are listed as being within the same classification, 514/675. Even if Applicants' claims encompass multiple independent and distinct inventions, the Examiner must examine all the claims if the search and examination of the claims can be made without serious burden. Manual of Patent Examining Procedure, 8th Ed. (August 2006), § 803, at page 800-4, left-hand column, lines 1-16. Because all three groups are listed as being within

the same classification, 514/675, the search of Groups I, II, and III would not impose any burden upon the Examiner, because a search concerning the patentability of the invention of one group is likely to uncover art of interest to the other group. Therefore, Applicants respectfully request that the Group III claims be rejoined to the claims of Groups I and II.

Moreover, the Examiner has restricted within each of claims 16-48, *i.e.*, has attempted to separate the oligomers of a single claim into individual restriction groups. Restriction practice is not applicable to a single claim (See *In re Weber*, 198 U.S.P.Q. 332 (C.C.P.A. 1978) and its companion case, *In re Haas*, 198 U.S.P.Q. 334 (C.C.P.A. 1978)). These cases make it clear that 35 U.S.C. § 121 does not grant to the PTO the authority to refuse to examine a single claimed invention. Section 121 only applies to *plural* claimed inventions in *different* claims, wherein the different claims vary not just in scope, but in the invention to which each is directed.

Reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

Applicants believe that a full and complete reply has been made to the Restriction and Election of Species Requirement, and prompt and favorable consideration of this Reply is respectfully requested. It is respectfully believed that this application is now in condition for examination. Early notice to this effect is respectfully requested.

It is not believed that extensions of time or fees for net addition of claims are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net

addition of claims) are hereby authorized to be charged to our Deposit Account No.

19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



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Date: *January 29, 2007*

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